

Remarks

Applicant acknowledges receipt of the *Office Action* dated October 4, 2007 wherein the Patent Office maintained the rejection of claims 17-19, 23-26, 28, 30, 31, 33-36 and 38-42 under 35 U.S.C. § 103(a). In response, Applicant respectfully requests entry of the claim amendments submitted herein and reconsideration of the presently claimed application in view of the following remarks.

Status of Claims

Claims 17-19, 23-26, 28, 30, 31, 35, 36 and 38-42 were previously presented.

Claims 1-16, 20-22, 27, 29, 32 and 37 were previously canceled.

Claims 33 and 34 are currently amended.

Therefore, claims 17-19, 23-26, 28, 30, 31, 33-36 and 38-42 are currently pending in the application.

Claim Objections

Claims 33 and 34 are objected to for depending from now canceled claim 32. In response, Applicant has amended claims 33 and 34 to depend from claim 31, thereby addressing and obviating the objection.

Claim Rejections – 35 USC § 103(a)

In the *Office Action*, the Patent Office maintained the rejection of claims 17-19, 23-26, 31, 33-36 and 40-42 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,844,797 to *Johnson* in view of U.S. Patent No. 5,957,693 to *Panec*. The Patent Office also maintained the rejection of claims 28, 30, 38 and 39 under 35 U.S.C. § 103(a) as being unpatentable over *Johnson* in view of *Panec* and further in view of U.S. Patent No. 5,651,678 to *Phillips*.

In response, Applicant respectfully traverses these rejections and submits that the combination of the cited references does not establish a *prima facie* case of obviousness as to any of the pending claims 17-19, 23-26, 28, 30, 31, 33-36 and 38-42 at least because: (1) there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the *Johnson* reference with *Panec* and/or *Phillips*; (2) the references fail to teach or suggest all of the claimed limitations; and (3) the claimed invention is not a predictable result of combining *Johnson* with *Panec* and/or *Phillips*.

Johnson is directed to a photograph album for a selected theme comprising pre-printed pictures or views and accompanying text “to provide the user with guidance and inspiration to take a corresponding series of photographs on the same theme” (Abstract). The user’s photographs are substituted for the pre-printed pictures or views to provide “a structured album of photographs and appropriate accompanying text” (Abstract). In one embodiment, the photograph album is in the form of a guidebook appropriate to a geographic location, historic building or the like, with spaces to receive photographs taken by the user. The stated purpose is to “provide a personalized yet organized record of the visit” while providing “additional interest for third parties viewing the album in the way that a disorganized collection of individual photographs will not” (col. 1, lines 13-26). Thus, *Johnson* is directed only to a method of creating structured, organized and personalized photograph albums for a selected theme, which has nothing whatsoever to do with teaching a pre-reader to read.

Panec is directed to a method for promoting reading in a novice reader using a book that includes a story with two texts, one written at a reading level appropriate for a skilled reader and the other written at a lower reading level appropriate for the novice reader. Thus, the method disclosed by *Panec* promotes reading by using a traditional, pre-assembled, non-personalized book.

Phillips teaches an educational aid and a method for using the system to teach students to read using sight-word vocabularies. The method relies on the student's natural ability to recall information, such as simple songs, rhymes, and stories which are easily memorized (col. 5, lines 53-55). Thus, the method disclosed by *Phillips* promotes sight-word reading based on memorization.

I. There is No Motivation to Combine the Cited References

In the *Office Action*, the Patent Office takes the position that, because the cited references relate to printed matter that is designed to be shared with another person, there is motivation to combine the cited references for the purpose of encouraging and facilitating a novice reader to learn to read by making the experience more interesting for the child. *Office Action* at 10.

In response, Applicant respectfully submits that there is no suggestion or motivation to modify *Johnson*, or to combine *Johnson* with *Panec* and/or *Phillips*, either within the references themselves, or in the knowledge generally available to one of ordinary skill in the art. In particular, *Johnson* is directed only to a method for creating structured, organized and personalized photograph albums for a selected theme. *Johnson* clearly has nothing to do with teaching a pre-reader to read, nor does *Johnson* make any suggestion whatsoever that its method for creating a photograph album could be used for such purposes. Moreover, one of ordinary skill in the art of teaching someone to read would not be motivated to look to the art of photograph albums for guidance. As such, Applicant submits that neither the references themselves, nor the knowledge generally available to one of ordinary skill in the art would suggest or provide motivation to combine elements of methods for constructing photograph albums as disclosed by *Johnson* with elements of methods for teaching someone to read as disclosed by *Panec* and/or *Phillips*. In fact, modifying the *Johnson* photograph album as

suggested by the Patent Office would detract from the interest that adults would have in viewing the album, which seems inconsistent with the purposes set out in the *Johnson* reference.

II. The Cited References Fail to Teach or Suggest All of the Claim Limitations

In the *Office Action*, the Patent Office takes the position that all of the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods. *Office Action* at 10-11.

In response, Applicant respectfully submits that the combination of *Johnson* with *Panec* and/or *Phillips* fails to establish a *prima facie* case of obviousness as to any of the pending claims 17-19, 23-26, 28, 30, 31, 33-36 and 38-42 presented herein at least because none of the prior art references, either alone or in combination, teaches or fairly suggests all of the claimed limitations. In particular, with respect to independent claims 17, 31 and 42, the cited references fail to teach or fairly suggest a process comprising: obtaining a repetitive language kit having a theme related to a planned shared experience between a reader and a pre-reader, the reader sharing an actual experience with the pre-reader corresponding to the planned shared experience, memorializing the actual shared experience between the reader and the pre-reader through one or more pictorial representations, constructing a personalized repetitive language book including said pictorial representations, and the reader reading a plurality of pages of said book to the pre-reader. Instead, the *Johnson* reference discloses a method whereby a user obtains a photograph album with a theme, the user has an outing or experience related to the theme, the user memorializes his or her outing or experience with photographs, and the user later shares the assembled photograph album with a third party. There is no planned shared experience between the user and the third party related to the photograph album theme, and the actual shared experience between the user and the third party (reviewing the photo album) is also unrelated to

the photograph album theme. Thus, *Johnson* fails to teach or suggest the claimed “planned shared experience” between a user (such as a reader) and a third party (such as a pre-reader) related to the theme of a repetitive language kit or the claimed “actual shared experience” between the user and the third party corresponding to the planned shared experience.

Neither *Panec* nor *Phillips* make up for this lack of teaching by *Johnson*. Instead, neither *Panec* nor *Phillips* teach or suggest that their methods and materials used for teaching a person to read have anything whatsoever to do with a planned shared experience between the reader and the pre-reader related to a theme of the materials, the reader sharing an actual experience with the pre-reader corresponding to the planned shared experience, or memorializing the actual shared experience between the reader and the pre-reader.

III. The Claimed Invention is Not a Predictable Result of Combining the References

In the *Office Action*, the Patent Office takes the position that the combination of cited references would have yielded predictable results to one of ordinary skill in the art at the time of the invention. *Office Action* at 11.

In response, Applicant respectfully submits that combining *Johnson* with *Panec* and/or *Phillips* would not predictably yield the claimed processes by which a reader facilitates the reading skills of a pre-reader involving a repetitive language kit with a theme related to a planned shared experience between the pre-reader and the reader, and the reader and pre-reader actually sharing and memorializing that experience with photographs. Instead, the predictable result of combining the *Johnson* reference with *Panec* and/or *Phillips* would be a method that employs a *Johnson* photograph album prepared by the reader alone, without sharing an experience with the pre-reader, wherein the photograph album includes the repetitive text of *Panec* and/or the sight-word text of *Phillips*. As such, the combination of *Johnson* with *Panec* and/or *Phillips* fails to

predictably yield the claimed process that involve the reader and pre-reader sharing and memorializing an experience related to the theme of the personalized repetitive language book.

Accordingly, Applicant respectfully submits that independent claims 17, 31 and 42 are patentably distinguishable over *Johnson* in view of *Panec* and/or *Phillips*. In addition, dependent claims 18, 19, 23-26, 28, 30, 33-36 and 38-41, each of which depends from and incorporates the limitations of independent claim 17 or 31, are likewise patentably distinguishable over the cited references.

In view of the foregoing remarks, Applicant believes that the patentability of the pending claims has been clearly established, and these claims are now in condition for allowance. Accordingly, Applicant respectfully requests withdrawal of all remaining rejections, and issuance of a *Notice of Allowance*.

CONCLUSION

Entry of the foregoing amendments, consideration of the accompanying remarks, reconsideration of the application, and withdrawal of the substantive rejections is respectfully requested by Applicant. No new matter is introduced by way of the amendments. It is believed that each ground of rejection raised in the *Office Action* dated October 4, 2007 has been fully addressed.

If any fee is due as a result of the filing of this paper, please appropriately charge such fee to Deposit Account Number 50-1515 of Conley Rose, P.C., Dallas, Texas. If a petition for extension of time is necessary in order for this paper to be deemed timely filed, please consider this a petition therefore.

If a telephone conference would facilitate the resolution of any issue or expedite the prosecution of the application, the Examiner is invited to contact the undersigned at the telephone number given below.

Respectfully submitted,

CONLEY ROSE, P.C.

Date: January 4, 2008
5601 Granite Parkway, Suite 750
Plano, Texas 75024
Telephone: (972) 731-2288
Facsimile: (972) 731-2289

Shannon W. Bates
Shannon W. Bates
Registration No. 47,412
ATTORNEY FOR APPLICANT